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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,404

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Toshifumi Hashiba

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EXAMINER

TESKIN, FRED M

ART UNIT

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1796

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,404	Applicant(s) HASHIBA ET AL.	
	Examiner Fred M. Teskin	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This Office action is responsive to the reply filed on 23 September 2008. Claim 1 has been amended; new claims 10-14 have been added. Claims 1-14 are currently pending and under examination herein.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 provides the limitation to “the anionic functional group”. There is insufficient antecedent basis for this limitation in the claim or in any claim from which claim 14 currently depends (*cf.*, claim 12, final line).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/512,230. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ merely in matters of scope as detailed in the previous Office action, see page 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-14 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5026800 (Kimura).

The rejection is maintained for the reasons of record (see pp. 4-5 of previous Office action) and those set forth below. Regarding new claims 10-14, it is noted that the new claims are all readable on oval-spherical organic polymer particle produced by

solution polymerizing a first organic monomer with a second organic monomer, where a salt of (meth)acrylic acid and a (meth)acrylic monomer are selected as the first and second monomer, respectively. Kimura in Examples 8-9 polymerizes an aqueous solution of monomers including sodium acrylate and acrylic acid to produce polymer powder. Sodium acrylate and acrylic acid qualify as species of said salt and (meth)acrylic monomer as recited in claim 10. In Example 8, the polymer powder is characterized by an average length of 3000 μm and an average breadth of 550 μm , giving a ratio (L/D) of 5.45. In Example 9, reported values for average length and average breadth equate to a L/D ratio of 5.3. This indicates the disclosed polymer powder has a ratio of major axis to minor axis in compliance with the claimed relationship, although not measured in the manner specified in claim 10.

Applicants' arguments with respect to claims 1-14 have been fully considered but they are not persuasive.

The arguments directed to claim 10 are addressed in the above discussion of Kimura as applied to the new claims.

Regarding claims 1-9, applicants argue that Kimura does not teach or suggest solution polymerization in water, a water-soluble organic solvent or a mixed solvent of water and a water-soluble organic solvent, as recited in amended claim 1. While it is true, as noted by applicants, that Kimura in Examples 8 and 9 utilizes a polymerization medium of cyclohexane and water to produce sausage-like particles, instant claims 1-5 and 10-14 are product claims drawn to an oval-shaped organic polymer particle as such

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and not to its method of production. Cyclohexane and water are specific solvents named by applicants as useable in the polymerization reaction to produce the instantly claimed particle (*cf.*, Specification at page 17, line 29 and page 18, line 6) and it has not been alleged, much less shown, that polymerization in a water-soluble organic solvent necessarily produces a substantially different product, compared to the particles obtained using a cyclohexane/water medium as per Kimura. Furthermore, Examples 8 and 9 do not represent the full scope of the disclosed invention. In fact these examples, which utilize a particular reverse-phase suspension system, illustrate an embodiment of the most preferable method to obtain water-absorbent polymer powder according to Kimura (see col. 3, lines 24-35). In addition to the reverse-phase suspension polymerization, Kimura teaches a procedure including aqueous solution polymerization as a usable condition to obtain polymer powder usable in the disclosed invention (see col. 7, lines 31-35). In light of this teaching, it is submitted that those of ordinary skill in the art would have expected solution polymerization in water to be a viable alternative to reverse-phase suspension polymerization in terms of producing polymer powder having the parameters of particle size and shape prescribed by Kimura. Accordingly, the continued rejection over Kimura is still deemed tenable and therefore must be maintained.

No claims are in condition for allowance at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred M Teskin/

Primary Examiner, Art Unit 1796

FMTeskin/12-30-08